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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,707	09/30/2003	May Tom-Moy	10031347-1	8124

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER

CHIN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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1641

MAIL DATE	DELIVERY MODE
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07/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/676,707	Applicant(s) TOM-MOY ET AL.	
	Examiner Christopher L. Chin	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-20 is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 9 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague. The limitation added to the end of step (a) is confusing. If the pad of resistive material is to support a probe, how can this be possible if the resistive material is inert to the conditions used to bind the probe to the pad? If the pad is inert to the conditions that bind the probe to the pad, then how can the probe become attached to the pad? In step (b), the insertion of "preferentially" is confusing as it suggests deposition of metal ions in places other than between the electrodes. Part (b) is further confusing in now saying that the metal ions are only provided "when the target is present in the sample". The metal ions seem to provide an indication that the target is present, so if one knows that the target is already present then why even use the metal ions? The metal ions seem to have no relationship to the detection of target, as presently claimed for the reasons set forth in the previous office action.

Claim 8 suffers from the same deficiencies as claim 1 with respect to the resistive material being inert to the conditions used to bind the probe to the pad.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1641

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7, 8, 10, 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al (Science, 2002) as evidenced by Fluke Corporation (Fluke Model 187 & 189 True RMS Multimeter Users Manual, 2000) and in view of Eggers et al (US Patent 5,891,630) for the reasons of record.

In response to this rejection, Applicants argue that Park et al fails to teach or suggest a pad of resistive material as claimed. Applicants point out that SMPB is a protein crosslinker and is clearly not inert to conditions used to bind probe of Park et al thereto.

Applicant's arguments have been considered but are not convincing. As set forth above in the 112 2nd paragraph rejection, the nature of the resistive pad is not clear. If indeed the pad of the instant invention is inert to the conditions present for binding of probe to the pad, then there can be no probe attached to the pad for reaction with target in a sample. Until the nature of the resistive pad can be clarified, the resistive material in Park et al is still seen to read on the resistive pad of the instant invention.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al (Science, 2002) as evidenced by Fluke Corporation (Fluke Model 187 & 189 True RMS Multimeter Users Manual, 2000) and in view of Eggers et al (US Patent 5,891,630) as

Art Unit: 1641

applied to claims 1-5, 7, 8, 10, 11, 13, and 14 above, and further in view of Cheung (US Patent 5,132,242) for the reasons of record.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al (Science, 2002) as evidenced by Fluke Corporation (Fluke Model 187 & 189 True RMS Multimeter Users Manual, 2000) and in view of Eggers et al (US Patent 5,891,630) as applied to claims 1-5, 7, 8, 10, 11, 13, and 14 above, and further in view of Sandstrom (US Patent 6,545,758) for the reasons of record.

Allowable Subject Matter

6. Claims 17-20 are allowed.

7. Claims 9 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1641

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Chin whose telephone number is (571) 272-0815. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher L. Chin/
Primary Examiner, Art Unit 1641

7/6/08